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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,160	01/20/2004	Silke Kohlhasse	P24855	6657

  

7055	7590	10/01/2007
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EXAMINER	
JEAN-LOUIS, SAMIRA JM	

  

ART UNIT	PAPER NUMBER
1609	

  

NOTIFICATION DATE	DELIVERY MODE
10/01/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

## Office Action Summary

**Application No.**

10/759,160

**Applicant(s)**

KOHLHASE ET AL.

**Examiner**

Samira Jean-Louis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date Sheets (3).
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Election/Restrictions**

Applicant's election with traverse to various species in the reply filed on 08/13/07 is acknowledged. Upon consideration of applicant's request to withdraw the species election requirement, examiner has decided to examine all claims herein on the merits.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d) for foreign priority based on an application filed in Germany on 01/20/2003, which papers have been placed of record in the file.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19-39, and 42-77 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-32, 35-39, and 42-80 of copending Application No. 10,759,254 in view of Riedel (U.S. Patent 6,558,680 B1).

In this instant application, the conflicting claims are not completely identical. However, they are not patentably distinct from each other because both applications are directed to a cosmetic composition comprising: fatty acids, fatty alcohols, amphiphilic or associative or siloxane polymer, sodium or potassium hydroxide, polyethoxylated fatty acid esters, and a surfactant (see claim 19 of instant application vs. claims 19 of Application No. 10,759,254).

While the instant application does not include dyes in its composition, Riedel (U.S. Patent 6,558,680 B1) discloses the use of dyes to such compositions as it gives a lustrous feel to the skin. Thus, it would have been obvious to one of ordinary skill in the art to add the dyes of Riedel to the composition of the instant application in order to achieve such lustrous feel on the skin.

Thus, the aforementioned claims of the instant application are substantially overlapping in scope as discussed hereinabove and are prima facie obvious over the cited claims of corresponding application No. 10,759,254.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 19-77 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Riedel (U.S. 6,558,680 B1) in view of Chapin (U.S. 4,370,319).**

Riedel et al. teaches cosmetic or dermatological compositions containing fatty acids, fatty alcohols, non-polar lipids and ethoxylated fatty acid esters (see abstract). In addition, it is further noted in Riedel that such composition can comprise auxiliaries and/or additives such as surfactants (i.e. laureth-4, see column 9, line 15, and lines 17-38; column 11, lines 14-24), moisturizers (see column 11, lines 14-24, which teaches the limitations of instant claims 66-67) and other usual constituents of cosmetic or dermatological formulations, such as polymers (see column 11, lines 14-24). Riedel also teaches that such a composition can also comprise emulsifiers such as

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acrylate/C<sub>10-30</sub>-alkyl acrylate cross polymer which is conventionally known in the art as an associative polymer (see column 8, lines 58-59, which meets the limitations of instant claims 19-20, 23 and 29), cetyl dimethicone (i.e. trade name Abil Wax 9840) conventionally known in the art as a siloxane elastomer (see table 1, which meets the limitations of instant claims 47-48), PEG-40 hydrogenated castor oil conventionally known in the art as a solubilizer (see column 9, line 5, which meets the limitations of instant claims 62-65 ) and ethanol (see column 6, line 65) that can be formulated as a skin protection cream, cleansing milk, sunscreen lotion or as a decorative cosmetic (see column 10, lines 1-7, which meets the limitations of instant claims 70-77). Importantly, the composition of Riedel et al. specifically discloses the fatty acids stearic and palmitic (instant claims 21 and 26) as a preferred embodiment of the invention including the use of the fatty alcohol cetearyl alcohol and the silicone oil cyclomethicone (see example 8).

Riedel does not specifically teach a skin care composition entailing the addition of component (IV) of at least one of sodium hydroxide and potassium hydroxide. Chapin et al., however, teaches a skin conditioning composition comprising an alkaline agent such as sodium hydroxide to neutralize the composition (see column 5, lines 65-68, which meets the limitations of instant claims 19-20, 24, 30, 49-52).

Thus, to one of ordinary skill in the art at the time of the invention would have found it obvious to add sodium hydroxide (Chapin) in order to neutralize the instant cosmetic and dermatological composition of Riedel in view of the fact that such

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composition may cause an effect on the acidity of the composition. Given that Riedel teaches a cosmetic and dermatological composition of fatty acids, fatty alcohol, ethoxylated esters, surfactant (such as laureth-2), and non-polar lipids, and Chapin discloses that sodium hydroxide can be used as a neutralizing agent, one of ordinary skill would have been motivated to add the sodium hydroxide of Chapin to the composition of Riedel with the expectation of adjusting the pH level of the composition in the absence of evidence to the contrary. Thus, claims 19-77 are prima facie obvious over the teachings of Riedel in view of Chapin.

Regarding the term "substantially free" recited in claims 34-35, it is considered as a broad term. Thus, for the purpose of examination, examiner is interpreting the term to mean in the range of 0.2-10% mono- and di-fatty acid esters of glycerol and glycol.

In addition, while the exact percentage of the polymer and ethanol are not disclosed by Riedel, it is generally noted that differences in concentration, ranges or percentages do not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Given that applicant did not point out the criticality of specific ranges or percentages of the invention, it is concluded that the normal desire of scientists or artisans to improve upon what is

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already generally known would provide the motivation to determine where in a disclosed set of percentage or ranges is the optimum combination of percentages.

Regarding the saponification of the fatty acids as recited in claims 53-54, it is considered that one of ordinary skill in the art at the time of the invention was made would find it obvious to conclude that the composition of Riedel would possess the same percentage of saponified fatty acids as that disclosed by the applicant given that these compositions both entail the same ingredients, therefore, it would be expected that these ingredients would not lead to no more than 9% of saponified fatty acid acids.

It is noted that In re Best, 195 USPQ 430, and In re Fitzgerald, 205 USPQ 594, discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

### ***Conclusion***

Claims are rejected. No claims are allowed.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samira Jean-Louis whose telephone number is 571-270-3503. The examiner can normally be reached on 7:30-5 PM EST M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SJL

09/20/2007

  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER